

Applicants direct the Examiner's attention to the corresponding EP patent, a copy of which is attached hereto as Exhibit A, which lacks any mention of water-soluble polymers. Furthermore, the experiments described in the patent application appear to result only in water-insoluble polymers.

For example, beginning at the bottom of page 25 of EP 502194 A1, polymerization reactions are discussed. For reaction 1, no solubility characteristics are discussed, but for reaction 2, the precipitated polymer is extracted with hot ethanol and washed with methanol. Since water is more polar than methanol, which is more polar than ethanol, a skilled artisan would expect this polymer to be even less soluble in water than it is in methanol, which appears not to dissolve the polymer.

More polymerization reactions are discussed beginning at the bottom of page 32. The products of reactions 1-3 are described as being precipitated with water and/or being washed with water, indicating insolubility in water. Reaction 1 on page 34, the only reaction in this set with solubility information, describes washing the precipitate with water.

Additional polymerization reactions are discussed on pages 39-40. The product of the first of these (3a) is soluble in THF, but is precipitated by methanol. Thus, a skilled artisan would expect this polymer to be insoluble in water as well. In 3b, the product of the first reaction is insoluble in methanol, and thus is presumably insoluble in water, and the product of the next reaction is clearly soluble in xylene (very non-polar) and insoluble in methanol, leading to the conclusion that this polymer is insoluble in water as well. The product of the third reaction apparently precipitates from water during the reaction and is later washed with water, and the product of the fourth reaction is washed with water, indicating that it, too, is insoluble in water. In section 3c, the polymeric product is washed with hot water.

The paragraph beginning at line 50 states, "The CD polymers used in the present invention obtained as described above are insoluble in water or in certain organic solvents...." The paragraph on page 2, lines 45-47, states that "another object of the present invention is to provide a cyclodextrin polymer which is insoluble in water".

These statements only reinforce the experimental protocols, which appear to indicate that all of the polymers discussed in the application are insoluble in water. Although it is unclear whether the abstract is merely a typographical error or is the expression of unfulfilled dreams, it is plain that EP 502194 A1 does not enable water-soluble cyclodextrin polymers as presently claimed, and that a skilled artisan could not have arrived at such polymers using this disclosure without excessive experimentation, even if such polymers were envisioned.

This interpretation is reinforced by the admissions of the patentholders themselves. During prosecution of the EP application, the applicants stated that “**water insoluble cyclodextrin polymers** are claimed to make the claim consistent with the description,” (emphasis in original) and that “the present invention relates exclusively to **water insoluble** cyclodextrin derivatives.” (emphasis in original) See the response filed December 7, 1995, a copy of which is attached hereto as Exhibit B. They also amended the specification to clarify that the invention is water-insoluble polymers, as can plainly be seen by comparing the published application to the issued EP patent. Accordingly, this application does not anticipate the subject matter presently being claimed, because any subject matter that might otherwise overlap with the presently claimed subject matter is not enabled as the inventors themselves have admitted. Moreover, there would have been no motivation to prepare water-soluble polymers as presently claimed, which are clearly disfavored and for which no utility is taught by this reference. Reconsideration and withdrawal of this rejection are respectfully requested.

CONCLUSION

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the pending rejections. Applicants believe that the claims are now in condition for allowance and early notification to this effect is earnestly solicited. As suggested by Examiner Wilson in a telephonic interview, Applicants respectfully request that all future communications from the Office in this case be reviewed by a supervisor prior to being mailed. Furthermore, Applicants respectfully request an

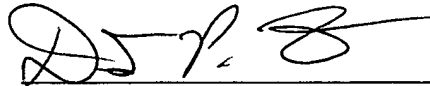
interview with the Examiner and his supervisor before the mailing of any further rejection of claims in this application. Any questions arising from this submission may be directed to the undersigned at (617) 951-7000.

If there are any other fees due in connection with the filing of this submission, please charge the fees to our **Deposit Account No. 18-1945**. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit account.

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Respectfully Submitted,



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